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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,002	08/02/2001	Stephen Anderson	RU-0115	4899

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LICATLA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT PAPER NUMBER

1637

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,002

Applicant(s)

ANDERSON ET AL.

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. Since the priority issue is not relevant for the current application, it will not be further addressed. (Though Applicant's attention is directed to page 4 of the BPAI decision where the BPAI states that the present claims are not supported by 09/181,601 under 35 U.S.C. 112, first paragraph).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by the University of Texas at Galveston campus as evidenced by Mumenthaler et al (J. Mol. Biol. (1995) 254:465-480) and an email from Dr. Werner Braun (August 15, 2005)(attached).

4. The examiner takes official notice that one year before the filing date of this application, the University of Texas at Galveston campus comprised a computer, an NMR facility which had a spectrometer, data collection device, and computer algorithms to analyze the NMR spectra and determine the tertiary structure of the proteins including the NOAH program for automated assignment of NOESY spectra, as well as laboratories for expressing proteins, access to the Wisconsin programs which can parse

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target polynucleotides, and internet access to the Protein Data Bank and the DALI webserver.

The BPAI specifically challenged at page 9 of the decision:

“Here, the examiner has not pointed to any section(s) in Mumenthaler which teach (i) a lab for expressing the putative domain of an unknown protein as set forth in subpart (B); (ii) a database as recited in subpart (H); and (iii) a fourth computer as required by subpart (1), of claim 12. As highly likely as it may be that the university does in fact have the referenced laboratory, database and computer, we remind the examiner that an anticipation rejection must be based on substantive evidence, not speculation. Since we do not find, and the examiner has not pointed out, any teachings in Mumenthaler of a laboratory for expressing protein domains (B), a database which stores the structure and function of known proteins (H), and a computer capable of determining the structural homology between the three dimensional structure of an unknown protein and a known protein (1), we do not find that it (Mumenthaler) anticipates the subject matter of claim 12.”

The elements argued by the BPAI as absent in the rejection are met by the email from Dr. Braun. Dr. Braun notes that UTMB had a laboratory that could express protein in 1995, internet access to the protein databank at Brookhaven National Laboratory, and a computer algorithm capable of determining 3D structural homology between the known and unknown proteins as discussed in his email. This provides express evidence that the university had the referenced laboratory, database and computer.

Response to Arguments

5. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive.

Applicant misstates the test for anticipation under 35 U.S.C. 102(b). The statute is not limited to things described in printed publications but also encompasses

inventions where were in "Public Use" in this country more than one year prior to the date of application for patent. So the issue is NOT whether Mumenthaler described the elements but whether the elements were in Public Use at the University of Texas at Galveston. The combination of the Mumenthaler paper and the Braun email demonstrate that all of the elements were in "public use" more than one year prior to Applicant's invention.

Applicant also misstates the test imposed by the BPAI on the system. The Board agreed that "Here, we find that the examiner appears to recognize that claim 12 is simply directed to a series of components (see page 8 of Decision on May 23, 2005)." The addition of the term "comprising" does not invoke any particular relationship between the elements. That is, there is no requirement that they be in the same building, in the same laboratory, or owned by the same person. Applicant's entire argument rests on the notion that "integrated" requires some particular relationship. However, no such relationship is required by the claim. Therefore, the rejection is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey Fredman
Primary Examiner
Art Unit 1637

2/9/06